

REMARKS

This Amendment is intended as a full and complete response to the non-final Office Action mailed February 5, 2004. In the Office Action, the Examiner notes that claims 1-9 and 21-28 are pending and that claims 10-20 and 29-38 are withdrawn from consideration. By this amendment, claims 1 and 21 have been amended, all other claims remain unamended and arguments addressing the Examiner's rejections in each of these claims are provided below.

In view of both the amendments presented above and the following discussion, Applicants submit that none of the claims now pending in the application are anticipated under the provisions of 35 U.S.C. §102 or obvious under the provisions of 35 U.S.C. §103. Thus, Applicants believe that all of these claims are now in allowable form.

It is to be understood that Applicants, by amending the claims, do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive amendments.

Election/Restrictions

In accordance with Section 5 of the Examiner's Response, Applicants hereby affirm William Blake's provisional election with traverse of the claims of Group 1 (claims 1-9 and 21-28). Claims 10-20 and 29-30 of Group 2 and claims 31-38 of Group 3 are hereby withdrawn from prosecution. To the extent that this restriction requirement is maintained by the Examiner, Applicants reserve the right to subsequently file divisional applications in order to prosecute the inventions recited in any one or more of the non-elected groups of claims.

Objections

Drawings

The Examiner has objected to the drawings for failing to comply with 37 C.F.R. 1.84(p)(4) because the reference character "18" has been used to designate both the

connection between set top converter box 14 and monitor 20 and the local database.

In response to the Examiner's objections, Applicants have amended FIG. 1 by replacing repeated figure legend 18 with new figure legend 21 to represent the connection between set top converter box 14 and television or monitor 20. A Replacement Sheet incorporating the drawing amendments is enclosed. A corresponding correction to the written specification is also included to bring the specification into conformity with the drawing; no new matter has been entered.

Rejection under 35 U.S.C. §102

The Examiner has rejected claims 1-2, 5, 9, 21-22, 24 and 28 under 35 U.S.C. 102(e) as being anticipated by Smith et al. (U.S. Patent 5,754,940, hereinafter "Smith"). Specifically, the Examiner contends that Smith discloses a network headend, a plurality of downstream channels interfaced to said headend, and a plurality of terminal devices for receiving said downstream channels in accordance with the subject invention. Applicants respectfully traverse the rejection.

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim" (Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984)(citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 U.S.P.Q. 193 (Fed. Cir. 1983)) (emphasis added). Smith does not teach a tuner that selects downstream channels via one-way hyperlinking. As such, Smith fails to disclose each and every element of the claimed invention.

Applicants' independent claims 1 and 21 currently recite:

- "1. A system for broadcasting information over a television distribution network comprising:
 - a) a network headend for accessing information from one or more sources, and broadcasting said information;
 - b) a plurality of downstream channels interfaced to said headend for transmitting said information; and
 - c) a plurality of terminal devices for receiving said downstream channels, each said terminal device including:
 - 1) a tuner for receiving and selecting said downstream channels; and
 - 2) a terminal processor for receiving channel selection

and information requests from a user, and instructing said tuner to select one of said downstream channels, said terminal processor including programming for receiving an information request from a user, and in response thereto, instructing said tuner to select, via one-way hyperlinking, one of said downstream channels on which said requested information is being transmitted from said headend.

21. A method for requesting and receiving information in a television distribution network comprising:

- a) providing a network headend for accessing information from one or more sources, and broadcasting said information;
- b) providing a plurality of downstream channels interfaced to said headend for transmitting said information;
- c) providing a plurality of terminal devices interfaced to said downstream channels for receiving information on said channels, and formatting said information for display on a display device, each said terminal device including a tuner for receiving and selecting said downstream channels, and a terminal processor for receiving information requests from a user, and instructing said tuner to select, via one-way hyperlinking, one of said downstream channels;
- d) receiving a request for information in said terminal device from an input device;
- e) identifying a one of said downstream channels on which said information is to be transmitted;
- f) causing said tuner to select, via one-way hyperlinking, said one of said downstream channels; and
- g) receiving said requested information with said terminal device."

In particular, Smith discloses an interactive subscription television terminal (and system) for providing interactive services in the subscription television system. Inspection of the reference reveals that broadcast services and information in the system of Smith are derived from satellite-based or cable facilities-based transmissions which are subsequently provided to an end user by virtue of the two-way interactive terminals (terminals 7, 8 or 9 of Smith). Information from the terminals 7, 8 or 9 are received by an addressable transmitter 10 for "upstream" communications on data channels that are separate from "downstream" communications (col. 4, lines 35-56). In particular, upstream transmissions may be handled by, for example, a telephone line or spread spectrum transmission. There is no teaching, disclosure or suggestion of receiving information requests from a user by instructing a tuner in the system of Smith to selected downstream channels via one-way hyperlinking. That is, since Smith is only

concerned with broadcast transmissions (via either satellite or cable sources), there is no specific teaching or disclosure of Internet related content that is accessed via hyperlinking to the Worldwide Web. The Examiner's offered disclosure in Smith of channel mapping in the RAM 217 of Smith which correlates keypad entered channels with either a channel frequency or a screen number falls short as it is only in regards to either stored screen information as part of the interactive subscription services (i.e., in a hotel checkout procedure) or the selection of a subscription feature. Either of these circumstances does not occur via hyperlinking.

By contrast, Applicants' invention teaches a terminal processor that controls operation of a tuner that stores channel mapping and hyperlink request identification information for any number of user selectable user hyperlinks or accessible web pages or sites. When a user actuates a hyperlink button on a remote control during a broadcast, hyperlinks are identified and Internet-based information is made available to the user (page 12, lines 3-12) without the need for an upstream channel extending far back into the headend to properly process the request. One-way communication is a readily understood phrase in the art to convey the direction of information as traveling from a cable headend to system end users and is described in part at page 2, lines 19-22 of the specification. Further description of the directionality of certain types of CATV systems (and the one specifically discussed in the present invention) may be found at page 7, lines 17-21; hence, no new matter has been entered by virtue of the amended claims. Specifically, reference is made to a plurality of downstream channels 16 and one or more upstream channels 17 as making up the bi-directional aspect. The upstream channel can be used for sending information from the end users (settops 14) to the headend 12 to establish two-way communication. It is respectfully submitted that the subject invention performs without need for such two-way or bi-directional aspects. Accordingly, the one-way hyperlinking as presented in the claims is understood to be in the downstream direction of the system and it is respectfully submitted that Smith does not disclose all of the features of the claimed invention.

As such, Applicants submit that independent claims 1 and 21 are not anticipated and fully satisfy the requirements of 35 U.S.C. §102 and are patentable thereunder. Furthermore, claims 2, 5, 9, 22, 24 and 28 provide additional limitations and are

dependent directly or indirectly from independent claims 1 and 21. As such, and for at least the same reasons set forth above, Applicants submit that these dependent claims are not anticipated by the teachings of the prior art and fully satisfy the requirements of 35 U.S.C. §102. Therefore, Applicants respectfully request withdrawal of the rejection of claims 1-2, 5, 9, 21-22, 24 and 28.

Rejection under 35 U.S.C. §103

Claims 3-4 and 23

The Examiner has rejected claims 3-4 and 23 under 35 U.S.C 103(a) as being unpatentable over Smith et al. (U.S. Patent No. 6,195,530, hereinafter "Smith") in view of Rothblatt (U.S. Patent 6,105,060, hereinafter "Rothblatt") in further view of Etheredge (U.S. Patent 5,990,890, hereinafter "Etheredge"). Applicants respectfully traverse the rejection.

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather, the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 U.S.P.Q. 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 U.S.P.Q. 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added). The combination of Smith, Rothblatt and Etheredge fails to teach or suggest Applicants' invention as a whole.

As indicated earlier under the arguments regarding anticipation, Smith merely discloses an interactive subscription television system and nothing more. Nowhere in Smith is there any teaching or suggestion of hyperlinking information via a tuner to provide information requested by user. Furthermore, neither Rothblatt nor Etheredge bridges the substantial gap between Smith and Applicants' invention.

Specifically, Rothblatt discloses a system for providing global portable Internet access using satellite-based communications network. The problem to be addressed in Rothblatt is to improve satellite-based systems to provide Internet content to many different users who suffer from technologically poor communications systems (such as in geographic locations of Africa, Central America, South America and Asia). Rothblatt

also attempts to solve the problem of poor bi-directional communication in a satellite-based broadcast system. It is respectfully submitted that neither of these circumstances exist in the subject invention, nor is the subject invention offering a solution to such problems. Accordingly, one skilled in the art would not randomly look for Internet related technology and resultantly be motivated to adapt the low earth orbit satellite system of Rothblatt to the teachings of Smith to arrive at the subject invention.

Similarly, Etheridge discloses a system for interacting with the user interface which includes the system displaying a plurality of selection items on a display and displaying a first plurality of popup symbols in response to a user evoking an activation input item on an input device such as a remote control. Each of the popup symbols corresponds to an input item and the selection item thus allowing for a selection of items based on the proper input. This system was created to address a need for improved data entry and navigation through user interface without requiring undue amounts of key strokes and without unnecessarily cluttering a display screen with information at a time when a user entering such data and performing such navigation does not need the extraneous information (col. 2, lines 9-25 of Etheridge). However, since such problems were not recognized in the subject application as requiring attention or needing improvement, it is respectfully submitted that there is insufficient motivation to combine Etheridge with any other prior art citation to arrive at the subject invention. That is, it has been clearly identified by the Applicants that the subject invention solves the problems of facilitating channel hyperlinking capabilities in a network distribution system without the need for upstream channels and also providing for picture-in-picture capability without the need for multiple tuners. These features and aspects have plainly not been disclosed or otherwise suggested in the prior art. Therefore, the combined references fail to embrace the problems that the Applicants' invention solves. Therefore, the combination of Smith, Rothblatt and Etheredge fails to teach or suggest Applicants' invention as a whole.

Even if the three references could somehow be operably combined (and Applicants submit that they cannot be operably combined), the combination would merely provide an interactive subscription television system and plurality of terminals having enhanced lower earth orbit satellite broadcast capabilities and enhanced user

interface capabilities to reduce key strokes for data entry navigation. Therefore, since the combination of Smith, Rothblatt and Etheredge fails to teach or suggest the improvements and features of the subject invention, the combined references fail to teach or suggest Applicants' invention as a whole.

As such, Applicants submit that claims 3-4 and 23 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, Applicants respectfully request that the rejection be withdrawn.

Claims 6, 8, 25 and 27

The Examiner has rejected claims 6, 8, 25 and 27 under 35 U.S.C 103(a) as being unpatentable Smith et al. (U.S. Patent No. 6,195,530, hereinafter "Smith") in view of Schein et al. (U.S. Patent 6,002,394, hereinafter "Schein"). Applicants respectfully traverse the rejection.

It has been argued above with respect to the anticipation rejections that Smith does not provide the necessary teachings or disclosure to anticipate the subject invention. It is respectfully submitted that any supplementary references provided to show obviousness of additional features of the subject invention still does not in combination teach, disclose or suggest Applicants' invention as a whole. In this specific instance, any alleged PIP capabilities or features in Schein as alleged by the Examiner still do not, in combination with Smith, provide for a broadcasting system and/or method that instructs a tuner to select downstream channel information via one-way hyperlinking in accordance with the subject invention.

As such, Applicants submit that claims 6, 8, 25 and 27 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, Applicants respectfully request that the rejection be withdrawn.

Claims 7 and 26

The Examiner has rejected claims 7 and 26 under 35 U.S.C 103(a) as being unpatentable over Smith et al. (U.S. Patent No. 6,195,530, hereinafter "Smith") in view of Gordon et al. (U.S. Patent 6,621,870, hereinafter "Gordon"). Applicants respectfully traverse the rejection.

It has been argued above with respect to the anticipation rejections that Smith does not provide the necessary teachings or disclosure to anticipate the subject invention. It is respectfully submitted that any supplementary references provided to show obviousness of additional features of the subject invention still does not in combination teach, disclose or suggest Applicants' invention as a whole. In this specific instance, any alleged encoder/decoder capabilities or features for transitioning frames in Gordon as alleged by the Examiner still do not, in combination with Smith, provide for a broadcasting system and/or method that instructs a tuner to select downstream channel information via one-way hyperlinking in accordance with the subject invention.

As such, Applicants submit that claims 7 and 26 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, Applicants respectfully request that the rejection be withdrawn.

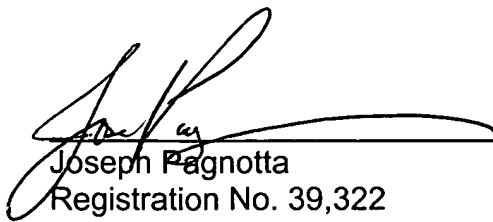
CONCLUSION

Thus, Applicants submit that none of the claims, presently in the application, is anticipated or obvious under the respective provisions of 35 U.S.C. §102 or §103. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall, Esq. at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: May 5, 2004



Joseph Pagnotta
Registration No. 39,322
Agent for Applicants

MOSER, PATTERSON & SHERIDAN, LLP
595 Shrewsbury Avenue, Suite 100
Shrewsbury, New Jersey 07702
Telephone: 732-530-9404
Facsimile: 732-530-9808

CERTIFICATE OF MAILING under 37 C.F.R. 1.8(a)

I hereby certify that this correspondence is being deposited on
May 5, 2004 with the United States Postal Service as
first class mail, with sufficient postage, in an envelope addressed to Mail Stop
Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Janet Konork
Signature

5/5/04
Date of signature